



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

*Handwritten signature*

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/625,543	07/24/2003	Gholam A. Peyman	116161-052	8200
29180	7590	08/24/2006	EXAMINER	
BELL, BOYD, & LLOYD LLC P. O. BOX 1135 CHICAGO, IL 60690-1135			KIM, VICKIE Y	
			ART UNIT	PAPER NUMBER
			1618	

DATE MAILED: 08/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/625,543

Applicant(s)

PEYMAN, GHOLAM A.

Examiner

Vickie Kim

Art Unit

1618

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 14-29 is/are pending in the application.
- 4a) Of the above claim(s) 22,24 and 25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14-21,23 and 26-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                                                                 |                                                                                         |
|-------------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                                                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                                            | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/24/2003</u> . | 6) <input type="checkbox"/> Other: ____.                                                |

**DETAILED ACTION**

***Election acknowledged***

1. Applicants' election the invention group II of claims 14-28 and saline as the species is acknowledged. The claims 14-21, 23 and 26-29 are readable thereon. The restriction is made without traverse. Therefore, the restriction requirement is deemed to be proper and made FINAL.
2. Upon the amendment filed 6/16/06, the claims 1-13 are canceled and claim 29 is added.
3. The claims 14-21, 23 and 26-29 are drawn to the elected invention and presented for the examination. The claim 22 and 24-25 are withdrawn from further consideration as being non-elected. The following rejections are made.

***Information Disclosure Statement(IDS)***

The information disclosure statement (IDS) is submitted on 10/24/2003. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner. Please refer to applicants' copy of the 1449 submitted herewith.

***Claim Rejections - 35 USC § 102/103***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 1618

5. Claims 14 rejected under 35 U.S.C. 102(b) as being anticipated by Hayashi et al (Retinal Changes..., 2000).

The claims are drawn to a method of forming a fold in an area of the macula of the eye comprising the steps as recited in the claim 14.

Hayashi et al teach a retinal translocation surgery to treat the neovascular maculopathies including macular degeneration (AMD) with scleral imbrication where intentional retinal detachment was performed by inserting saline solution into subretinal space after vitrectomy performed, see page 3/13. IT also teache the detached retina was then reattached by fluid air exchange and retinal folds were pushed aside using a back flush needle, where retinal folds are inevitably created, see page 2/13. Since macula and retina is are layers attached together, macula folds are readily envisaged as well as foveal relocation. All the critical elements are well taught and the claims are met.

Alternatively, although all the steps required by instant claims are not explicitly staed in the cited reference, it would have been obvious to one of ordinary skill in the art to perform retinal translocation surgery performing step by step procedure because to perform the surgery it is essential step to go thru each steps even though the terms are different in instant claims from cited reference. In light of instant specification, one would also readily understood that macula translocation and retinal translocation are also equivalent term as evidenced by applicant's own acknowledgement, see instant specification at page 4, paragraph 15 and paragraph 16. For instance, instant specifcaiton states " folding the retina to form a folded portion" (see paragraph 16)

Art Unit: 1618

whereas the claims recites" folding the macula to form a folded portion" (see claim 14, line 8), and thus, one skill in the art would readily understood the claimed subject matter is equivalent to each other and substituted one to the other.

All the claims are properly included in this rejection absent evidence to the contrary.

### ***Conclusion***

1. No claim is allowed.
2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickie Kim whose telephone number is 571-272-0579. The examiner can normally be reached on Tuesday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hartley be reached on 571-272-0616. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 10/625,543

Page 5

Art Unit: 1618

**VICKIE KIM**  
**PRIMARY EXAMINER**

Vickie Kim  
August 17, 2006  
Art unit 1618